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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,474	04/03/2006	Terrance P. Fenelon	13888.0002USWO	2695

23552 7590 04/05/2007  
MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

EXAMINER
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MATTHEWS, ABRAHAM M

ART UNIT	PAPER NUMBER
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1755

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/539,474

Applicant(s)

FENELON, TERRANCE P.

Examiner

Abraham M. Matthews

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 06/20/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-7, drawn to a pigment agglomerate.

Group II, claim(s) 8-14, drawn to a method of making a pigment agglomerate.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 1 is either obvious or anticipated by US Patent No. 3,856,550. Accordingly, the special technical feature linking the two inventions, a pigment agglomerate comprising a plurality of pigment particles and a plurality of carrier particles held to the pigment particles by interparticles forces, does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore, restriction is appropriate.

During a telephone conversation with Applicant's representative Mara E. Deboe at telephone No. (612) 332-5300 on March 26, 2007 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claim 8-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 1755

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-5,6 and 7 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5,9 and 10 of copending Application No.11,426,702. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 3,856,550 to Bens et al.

Regarding Applicant's claims 4 and 6, Bens et al. disclose that a plurality of pigment particles will tightly adhere to the surface of each carrier material particle forming what is essentially a composite (or agglomerate) article. (Bens et al., column 2, lines 36-43). Bens et al. also disclose that to prepare composite (or agglomerate) articles

Art Unit: 1755

of said invention one simply places a quantity (or plurality) of carrier particles in a container, adds a quantity (or plurality) of pigment particles and shakes the two materials together until all of the material in the container appears to have taken on the color of the pigment (Bens et al., column 3, lines 9-14).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3,5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 3,856,550 to Bens et al., in view of US patent No. 6,071,665 to Dickerson et al.

Art Unit: 1755

Regarding Applicant's claims 1,2,5 and 7, Bens et al., as applied to claims 4 and 6 above, disclose that a plurality of pigment particles will tightly adhere to the surface of each carrier material particle forming what is essentially a composite (or agglomerate) article. Bens et al. also disclose carrier particles held to the pigment particles by interparticle forces (Bens et al., column 3, lines 54-57).. Bens et al. also further disclose a pigment composite (or agglomerate), wherein the carrier particles comprise silica, as recited in Applicant's claim 2 (Bens et al., column 4, lines 6-10). Bens et al. also further disclose that insofar as the amount of pigment added is concerned, the weight percentage of pigment may vary within a considerable range. However, Bens et al. do not specifically disclose a pigment composite (or agglomerate), wherein: (1) a weight ratio of the carrier particles to the pigment particles is about 0.5:10 to 3:10, as recited in part (b) of Applicant's claim 1, and, (2) the pigment particles comprise iron oxide, as recited in claim 2, 5 and 7.

Nevertheless, Dickerson et al., also drawn to composite pigments or toner compositions, disclose that : (1) the weight percent of carrier particles (e.g., fumed silica), and pigment particles (e.g., iron oxides) in a toner composition, (i.e., in a composite pigment) is from about 0.4 to about 0.7, and from about 10 to about 70, correspondingly (i.e., carrier to pigment weight ratio terms of 0.4:10 to 0.7:70), and, (2) the pigment particles comprise iron oxide (Dickerson et al., column 8, lines 18-24; and lines 33-42). With regard to the claimed weight ratio ranges, the reference teaches overlapping ranges of weight ratios with the present claims. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the pigment composite of Bens et al. to comprise iron oxide, as taught by Dickerson et al., motivated by the fact that Dickerson et al. disclose that when the pigment particles are comprised of magnetites (iron oxides), possibility of use of single component toners (or single pigment particles) is becomes an advantage (Dickerson et al., column 8, lines 18-19).

Art Unit: 1755

Regarding Applicant's claim 3, Bens et al., as applied to claim 1 above, disclose that a plurality of pigment particles will tightly adhere to the surface of each carrier material particle forming what is essentially a composite (or agglomerate) article. The recitations of Applicant's claim 3 can be found in Bens et al., at column 3, lines 54-57.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abraham M. Matthews whose telephone number is (571) 272-2495. The examiner can normally be reached on M-F 8:00 -4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMM

  
DAVID SAMPLE  
PRIMARY EXAMINER